

REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated May 17, 2005. Reconsideration and allowance is requested.

Claims 1-5 remain in this application. Claims 6-17 have been canceled as a result of an earlier restriction requirement. Claims 18-22 are new and have been added by this amendment.

Formal Matters

In the Office Action Summary, the Examiner did not acknowledge the Priority Document. Specifically, none of the boxes under section 12 of the Office Action Summary were marked. The Priority Document was filed on June 21, 2001 with the application. Counsel respectfully requests that the Examiner acknowledge receipt of the Priority Document.

Claim Objections

In the Office Action, claim 2 was objected to because it contains limitations with quotation marks. Claim 2 has been amended to remove the quotation marks as recommended.

Claim Rejection Under 35 USC 112

In the Office Action, claims 1-5 were rejected under 35 USC 112, second paragraph, as being indefinite because the phrase "...above a predetermined distributor set priority level means." in claim 1 is unclear. Additionally, these claims were rejected because the limitation "...broad conditions..." is a relative term which renders the claim indefinite. Claim 1 has been amended to no longer include "a predetermined distributor" or the word "broad." Therefore, counsel for assignee believes that this rejection has been overcome.

Claim Rejection Under 35 USC 103

In the Office Action, the Examiner rejected claim 1-5 under 35 USC 103(a), as being unpatentable over Giovannoli (US 5,758,328). The counsel for assignee respectfully traverses.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaack* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2143. The counsel for assignee respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

The Examiner stated that Giovannoli discloses displaying to the consumer a subset of the commodities found above a predetermined distributor set priority level (column 5, line 37 - column 6, line 11). Counsel for assignee disagrees. Giovannoli's computerized system does not display to the consumer a subset of the commodities found but rather displays a response to a request for quotation given by the buyers and forwards the request for quotation to the selected sellers based on the filtering conditions given by buyers and/or sellers. Additionally, Giovannoli does not display results in the order of the determined priority level. Instead, Giovannoli discloses that the sellers may select to sell a good or not to sell a good but cannot give priority levels to sell by the filtering condition. Therefore, if one or more products meet the criteria provided by the consumer, Giovannoli cannot display to the consumer a subset of the commodities found by the search, in the order of the determined priority level. Therefore counsel does not believe that Giovannoli makes obvious the claimed embodiment under *In re Vaack* and MPEP 2143 because Giovannoli does not teach each and every element of the claimed invention and cannot be reasonably modified to do so.

Nevertheless, claim 1 has been amended to *further* distinguish it from Giovannoli. Claim 1 has been amended to include storing in a list of commodity names and promotion points corresponding to commodity names, and determining the priority level of commodities found by the search, on the basis of the promotion points stored in the list. Support for this amendment can be found throughout the specification and figures and specifically in figures 6-8. Since Giovannoli is incapable of promoting some goods more than others by utilizing promotion points, the currently amended claims are further distinguished from Giovannoli. Counsel for assignee believes that the amended claims are not obvious under Giovannoli and respectfully request that the claims be allowed.

In addition, claim 2 has also been amended so that the priority level of commodities are determined according to the sum of the promotion points related to the commodities found by the search and the promotion points related to the lower level of processing of the commodities. Giovannoli does not teach this limitation.

Regarding claims 3-5, the Examiner acknowledged that Giovannoli does not disclose a type of food, restriction on diet, or price constraints. Nevertheless claims 3-5 were rejected because "these limitations are not functionally involved in the steps of the recited method...these limitations are deemed to be non-functional descriptive material." Counsel for assignee respectfully traverses. According to MPEP 2106(IV)(B)(1)(b):

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

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In claims 3-5 the type of food, restriction on diet, or price constraints defines a functional interrelationship among that data and the computing processes performed when utilizing the type of food, restriction on diet, or price constraints data. Therefore, these limitations are not non-functional descriptive material and should be allowed in light of the fact that they are not disclosed by Giovannoli, as acknowledged. Additionally, counsel believes that claims 3-5 are allowable because they depend from independent claim 1, which is allowable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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